

REMARKS

Reconsideration and further examination of the subject patent application in light of the present Amendment and Remarks is respectfully requested. Claims 1-26 are currently pending in the application and stand rejected.

Rejection Under 35 U.S.C. §102(b)

Claims 1-24 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Carson, as set forth on pages 2-6 of the Office Action. In view of the claims as presently amended, applicant respectfully traverses this rejection.

Carson discloses an early style telephone communication system, which applicant informs us is embodied in a product originally introduced by AT&T Corp., and known in the industry as the “Merlin” system PBX. This was one of the early attempts to construct a digital telephone PBX. Such early digital telephone systems, as disclosed in Carson, required a six-wire cable (referred to as three pair of wires) for communication with the telephone, where various functions are segregated or handled with a dedicated wire pair (two wires). Carson discloses that two wires are required to provide power to the telephone, as this type of telephone was fairly “power hungry.” Two additional wires are required for bi-directional transmission of voice (Col. 3, lines 4-13), while the third pair provides the required control lines for sending commands to the telephone. This make for a rather bulky and cumbersome interface cable.

Applicant’s independent claims have been amended to recite a system using an industry-standard analog guestroom telephone having a two wire communication link for bi-directional voice and data transmission. Each independent claim also recites that the speed-dial data and the voice communication are transmitted over the same (and only) two-wire communication link. Such

elements are completely missing in Carson, which teaches a digital telephone using a six wire communication arrangement.

Applicant's invention is directed to an industry-standard analog guestroom telephone (page 24, lines 8-11). To save costs, guestroom telephones in hotels or other service industry establishments are almost all analog telephones, not digital telephones. Analog telephones and digital telephones are very different devices, which are controlled in very different ways. Even today, digital telephones are about three times the price of analog telephones, hence the reason why service industry establishments continue to use the less expensive analog telephones. Applicant's claimed invention uses the industry-standard analog telephone having a two-wire interface for handling all communication to and from the telephone unit and to and from the PBX, which is also disclosed in the specification (Figs 4, 5, 7, 12 and 16, see reference numeral 16). In applicant's claimed invention, all communication to and from the telephone occurs over a single pair of wires. That is, all control and commands, and all voice communication occurs over the same set of two wires (in addition to providing power to the telephone unit).

Such two wire control was not contemplated in 1984 when the Carson application was filed. Separate lines were needed for command and control data, as well as for voice communication. It would not have been feasible for the Carson system to use a single two wire pair to handle all communication, and such a system is not taught, disclosed or suggested in Carson. Because at least one significant element of applicant's claimed invention is missing from the Carson system, Carson cannot anticipate applicant's claimed invention. Accordingly, applicant asserts that the independent claims are allowable over Carson, and that claims depending from the independent claims, respectively are allowable as depending from allowable base claims.

Applicant respectfully notes that anticipation focuses on whether a claim reads on the product or process that a prior art reference discloses, not on what the reference broadly “teaches.” Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). As the Examiner is aware, each and every element of a claim must be shown in the “four corners” of the reference. “To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” PPG Industries v. Guardian Industries, 75 F.3d 1558, 37 U.S.P.Q.2d 1618 (Fed. Cir. 1996).

Rejection Under 35 U.S.C. §103

Claim 25 stands rejected under 35 U.S.C. §103 as being unpatentable over Hackett-Jones in view of Carson, as set forth in paragraphs 3-4 of the Office Action. In view of the claims as presently amended, applicant respectfully traverses this rejection.

The Examiner relies on Hackett-Jones as the primary reference in the rejection of independent claim 25. In paragraph 4 of the Office Action, the Examiner asserts that Hackett-Jones discloses the features of applicant’s claimed invention, and then states that Hackett-Jones does not disclose certain pertinent features, such as the controller, call recognition circuit, the computer configured to automatically call, and the computer configured to transmit speed-dial data. The Carson reference is then used to supply the missing features to support the Examiner’s rejection.

Hackett-Jones is directed to an information gathering system in a hotel environment. This appears to be the main feature for which this reference was cited. This reference does not teach or suggest any operation or feature where the actual guest-room telephone is programmed or otherwise acted on, that is, no computer or any other component of the system programs the speed-dial keys of the guest-room telephone. Hackett-Jones essentially discloses a “front-end” system that may interact

with a PBX to gather information, such as room occupancy, but is unrelated to applicant's claimed invention absent the environment in which it operates.

The problems addressed by Hackett-Jones are totally unrelated to the problems addressed by applicant. Applicant's invention addresses the need for automatically programming the speed-dial keys of a guest room telephone having a two wire or single pair interface. Hackett-Jones is completely unconcerned with this problem.

In light of the above explanation regarding the Hackett-Jones and the Carson system mentioned above, the combination set forth by the Examiner is now addressed. As set forth above, the Examiner uses Hackett-Jones as the primary reference. Applicant submits that an inventor starting with the Hackett-Jones reference in hand, would find it virtually impossible to arrive at applicant's claimed invention. Hackett-Jones does not even relate to automatic speed-dial programming of a guest room telephone. It is merely an information gathering system that gathers certain data by interrogating the telephone.

One skilled in the art of telephony and guest-room telephone technology using industry standard analog telephones having a single pair interface looking for a way to develop a low cost, error-free, easy and flexible approach to programming and reprogramming guest room telephones would have no reason to consult Hackett-Jones. Why would such an inventor look to a reference that merely discloses a front-end system in a hotel environment. He or she would not do so as this would not make sense and there is no motivation to do so.

Even the reverse situation cannot be supported. If one skilled in the art began with Carson in hand, would he or she be led to early digital PBX technology using a six wire interface and select Carson for suggestions to produce a low cost, error-free, easy and flexible approach to programming

and reprogramming guest room telephones. The answer is clearly that he or she would not do so because there is no teaching, suggestion or motivation in either reference to produce a system using an industry standard analog guest room telephone using a single pair interface.

As the Examiner is aware, it is impermissible to combine the teaching of prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The Examiner cannot pick and choose features from the prior art to recreate the claimed invention in hindsight without some teaching or suggestion in the references to support use of the particular claimed combination. Smithkline Diagnostics Inc., v. Helena Laboratories Corp., 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988). Applicant submits that neither reference alone or taken in combination teach or suggest applicant's claimed features.

Closing Remarks

The art made of record by the Examiner but not relied upon as a basis of rejection, does not, whether taken alone or in combination with Carson and Hackett-Jones, anticipate or render obvious any of applicant's claims as now amended in the application.

For the foregoing reasons, applicant submits that the subject application is in condition for allowance and earnestly solicits an early Notice of Allowance. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, the Examiner is respectfully requested to call the undersigned at the below-listed number.


The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or

even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. A duplicate copy of this sheet(s) is enclosed.

Respectfully submitted,

WELSH & KATZ, LTD.

By



Eric D. Cohen

Registration No. 38,110

June 22, 2004

WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500

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Group Art Unit

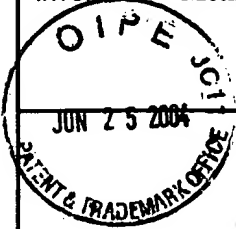
2643

Invention: Method And Apparatus For Programming GuestRoom Telephones

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I hereby certify that this Amendment And Reply*(Identify type of correspondence)*

is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

June 22, 2004*(Date)*Eric D. Cohen, Registration No. 38,110*(Typed or Printed Name of Person Mailing Correspondence)*

A handwritten signature in black ink, appearing to read "Eric D. Cohen".

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Amendment Transmittal Letter (Small Entity); Amendment And Reply Pursuant to 37 C.F.R. 1.111 And Response To Notice Of Non-Complaint Amendment; and Postcard.